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In re Application of	:	
WARD et al.	:	
U.S. Application No.: 10/031,862	:	DECISION ON PETITION
PCT No.: PCT/US01/07582	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 09 March 2001	:	
Priority Date: 09 March 2000	:	
Attorney Docket No.: 19978-088796	:	
For: METHOD FOR CONTROLLING	:	
IGNITION OF AN INTERNAL	:	
COMBUSTION ENGINE	:	

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(b)" filed 26 August 2002, which is being treated a Petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, James D. Meaney. The required petition fee of \$130.00 (37 CFR 1.17(h)) has been submitted.

BACKGROUND

On 09 March 2001, applicants filed international application no. PCT/US01/07582 which claimed a priority date of 09 March 2000. A Demand was not filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 20 months from the priority date, or at midnight on 09 November 2001.

On 09 November 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); preliminary amendment; and declaration of the inventors.

On 22 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b). The notification indicated that the declarations filed on 09 November 2001 were defective.

On 22 August 2002, applicants filed a Petition under 37 CFR 1.47(a) and the requisite fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (3) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition and the accompanying papers reveal that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to James D. Meaney. Petitioner states that "Mr. Meaney was forwarded the patent application and a new Declaration/Power of Attorney . . ." The declarant fails to specify what application papers were sent to the missing inventor and if the declarant has firsthand

knowledge of what papers were actually mailed. Was a complete application (specification, claims, and drawings) mailed to the missing inventor? Additionally, petitioner states, "[o]n August 21, 2002, the undersigned called (Mr.) Meaney. He instructed us to contact his attorney, Robert L. Myers. A telephone message was left with (Mr.) Myers to contact me to discuss the signing of the new declaration by Mr. Meaney. It was requested that a prompt response be made because a deadline was pending . . . Myers did not call back." Mr. Myers' lack of response cannot be construed as a refusal since the mailing of the petition occurred only one day after leaving the phone message. Has the petitioner been contacted by the non-signing inventor or his attorney since the filing of this petition?

As stated above, in order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to James D. Meaney, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

As to Item (4), an oath or declaration by each 37 CFR 1.47(a) applicant on his own behalf and behalf of the non-signing joint inventor has not been provided. The declaration executed by Lance Ward is defective in that it does not list James Meaney as an inventor. Therefore, item (4) has not been satisfied.

For the reasons stated above, it would not be appropriate to accept the application without the signature of James D. Meaney under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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